

REMARKS

Claims 1, 3, 5 and 7-15 are currently pending in the present application. Claims 7-13 have been withdrawn from consideration. Claims 1, 14 and 15 were amended in the response dated August 25, 2008.

In the Advisory Action dated October 8, 2008, the Examiner stated “[t]he proposed amendment relates to nonelected embodiment, see response filed 9/11/2006, page 3.” Applicant respectfully traverses.

Applicant has carefully reviewed the response filed September 11, 2006 and submits that the Examiner’s position is in error. The response states, in relevant part,

“For the purpose of examination of the present application, Applicants elect, with traverse, Group I, Claims 1-6 and 13-15.”

“For the purpose of examination of the present application, Applicants elect, with traverse, Species A, drawn to a laminate structure. The claims which are readable on the elected species are claims 1-5 and 14-15.”

In the Office Action dated September 26, 2006, the Examiner acknowledged that the elected group included claims 1-5, 14 and 15 and proceeded to examine these claims. In the response filed August 25, 2008, Applicant amended claims 1, 14 and 15 to narrow the coating composition that was already recited in the claims and had been previously examined by the Examiner. Thus, the present claims are still directed to the laminate structure as previously elected.

According to MPEP § 818.02(a), the claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application, and in

any request for continued examination (RCE) which has been filed for the application. Subsequently presented claims to an invention other than that acted upon should be treated as provided in MPEP § 821.03 and 37 CFR 1.145 (cited for the Examiner's consideration).

37 CFR 1.145 Subsequent presentation of claims for different invention.

*If, after an office action on an application, the applicant presents claims directed to an invention **distinct from and independent of the invention previously claimed**, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered. (emphasis added)*

Applicant respectfully submits that the “subsequent presentation of claims for different invention” guidelines are inapplicable in the present instance because Applicant has not presented claims that are distinct from and independent of the invention previously claimed. The term “independent” (i.e., unrelated) means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect. Inventions are “distinct” if the inventions as claimed are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is patentable (novel and nonobvious) over the other (though they may each be unpatentable over the prior art). *See* MPEP § 802.01.

Careful consideration of the above definitions of “independent” and “distinct” make it clear that the narrowing of the present claims do not rise to the level of making the amended claims unconnected in design or patentable over the previous claim set.

Accordingly, Applicant respectfully submits that the Examiner's statement in the outstanding Advisory Action is erroneous and respectfully requests reconsideration thereof.

In view of the foregoing, Applicant believes the pending application is in condition for allowance. A Notice of Allowance is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Monique T. Cole, Reg. No. 60,154 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: OCT 27, 2008

Respectfully submitted,

By 

John W. Bailey

Registration No.: 32,881

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant

MTC